

## **REMARKS**

Claims 7 and 10-13 are pending in the present application after cancellation of claims 8 and 9. In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant thanks the Examiner for acknowledging the claim for foreign priority, as well as indicating that all copies of the certified copies of the priority documents have been received.

### **I. Rejection of Claims 7-13 under 35 U.S.C. §101**

Claims 7-13 were rejected under 35 U.S.C. §101 as being directed to non-statutory matter because the process is not tied to a particular apparatus. In order to expedite prosecution, claim 7 has been amended to clearly associate the claimed method to a particular apparatus, i.e., a “method for operating a vehicle navigation system by enabling useful data including navigation data which is one of (a) stored on a data carrier and (b) transmitted into a data processing system associated with the vehicle navigation system.” In view of the foregoing amendment, removal of the rejection under 35 U.S.C. §101 is kindly requested.

### **II. Rejections of Claims 7-13 under 35 U.S.C. § 102(a), § 102(b) & 103(a)**

Claims 7-8, 10, and 12-13 were rejected under 35 U.S.C. § 102(a) as being anticipated by German Patent Document No. DE 101 55 485 (“Barkowski”), and claims 9 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Barkowski. Claims 7-8, 10, and 12-13 were rejected under 35 U.S.C. § 102(a) and § 102(b) as being anticipated by U.S. Patent Application No. 2002/0069360 (“Thoone”), and claims 9 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Thoone.

Independent claim 7 has been amended to incorporate additional limitations, including the limitations previously recited in claims 8 and 9. Claims 8 and 9 have been canceled. In view of the amendment of claim 7 incorporating the limitations previously recited in claim 9, Applicant respectfully submits that the anticipation rejections based on Barkowski and Thoone are now moot, since the Examiner acknowledges that the limitations previously recited in claim 9 are not taught in Barkowski and Thoone. Applicant will address the obviousness rejections based on Barkowski and Thoone, as applied against amended independent claim 7 and its remaining dependent claims 10-13.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed, and “obviousness cannot be sustained by mere conclusory statements.” See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). In addition, all the teachings of the prior art must be considered, including those which teach away from the claimed invention. (See MPEP 2143.01.II). To the extent that the Examiner may be relying on the doctrine of inherent disclosure to support the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Amended claim 7 recites, in relevant parts, “enabling the useful data for an area which is definable by a user of the useful data, wherein the useful data are enabled for an area defined by the user by one of (a) defining a center point and a radius of a circular region, or (b) specifying corners of the area.” In contrast to the above-recited limitations, the areas selectable by the user in the system of Barkowski are predefined regions, e.g., Germany north, Germany south, etc. Similarly, Thoone merely mentions providing “data for a particular country” to an authorized user, but there is no suggestion of enabling the useful data for an area defined by the user.

Independent of the above, to the extent the Examiner contends that, in view of teachings of either Barkowski or Thoone, “enabling for an area within a radius around a freely selectable center point” (as previously recited in claim 9, and similarly recited in amended claim 7) would have been “obvious to do so, as commonly known in the art, . . . with predictable results,” the Examiner does not provide any documentary support for the contentions, let alone state which obviousness rationale is being referenced (e.g., “substitution of one known element for another to obtain predictable results”; “use of known technique to improve similar devices”; or

“applying a known technique to a known device ready for improvement to yield predictable results”). Therefore, the Examiner’s contention is a mere conclusory statement which cannot sustain the obviousness conclusion.

Independent of the above, with respect to amended claim 13, which recites “wherein the area defined by the user is not limited to any political boundary,” the Examiner contends that col. 6, paragraphs 23-24 of Barkowski and the abstract of Thoone disclose the claimed feature. However, Barkowski clearly indicates that only predefined areas may be selected by the user, all of which predefined areas are limited by political boundaries, i.e., no selectable region crosses a political boundary. Furthermore, Thoone does not suggest anything about this claimed limitation.

The present invention provides the advantage over the prior art that a user can tailor the enabling of map data to such areas that are actually of interest to him, without being restricted to certain predefined regions or areas. For example, using the present invention, the user can enable map data in a user-defined border region between two countries, without having to enable the entire maps of the countries or predefined regions adjoining the border.

For at least the foregoing reasons, claim 7 and its dependent claims 10-13 are allowable over the applied Barkowski and Thoone references. Withdrawal of the rejections of pending claims 7 and 10-13 is requested.

**CONCLUSION**

In view of the above, it is respectfully submitted that all pending claims are allowable. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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